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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,893	08/24/2001	Robert Sesek	10010609-1	2504

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Intellectual Property Administration
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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,893

Applicant(s)

SESEK ET AL.

Examiner

Houshang Safaipoor

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-13,15-21 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,7,8 and 21 is/are allowed.
- 6) ☒ Claim(s) 9,13,15,16, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 10-12,19,20 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

JEROME GRANT
PRIMARY EXAMINER

DETAILED ACTION

1. *Response to Arguments*

Applicant's amendment filed on September 5, 2006 has been entered and made of record. Applicant's arguments have been considered but are not persuasive. Applicant argues that the cited prior art by Hideyuki does not show a scan window illumination device including a light source configured to generate a focused beam of light to trace at least a part of a perimeter of the scan window by directing the focused beam of light toward an upper or lower side of a scanable surface. Examiner disagrees. Hideyuki determines the size of the printing field of choice (page 5, second line of [0035]) and computes the field 11 in the manuscript installation field (scanning area) (page 5, fifth line of [0035]). CPU 31 turns on the LEDs to identify the field 11 (fig. 2A LEDs 8-9, page 6, first two lines). For the reasons stated examiner maintains his previous rejection.

2. *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 15 recites that "scanning light source includes the scan window

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illumination device and is configured to direct the focused beam of light.” There is no support in the specification for this limitation.

3. ***Claim Objections***

Claim 27 is objected to because of the following informalities: Claim 27 is dependent upon canceled claim 26. Appropriate correction is required.

4. ***Claims Canceled***

Claims 3-6, 14, 22-26 and 28-31 are canceled.

5. ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 9, 13, 15, 16, and 18 rejected under 35 U.S.C. 102(e) as being anticipated by Ko Hideyuki JP Publication No. 2000-358131.

Regarding claim 9, Hideyuki discloses a scan window apparatus for indicating a scan window within a scanable surface of a scanning device, the scanable surface having a first edge and a second edge intersecting the first edge, comprising:

a scan window definition device (3, drawing 2(A)) to allow a user to define the scan window (11) on the scanable surface (2, drawing 2(A)); and

a scan window illumination device including a light source (LEDs 8-9) configured to generate a focused beam of light to trace at least part of a perimeter of the scan window (11) by directing the focused beam of light toward at least one of the upper side and the lower side of the scanable surface (paragraph [0031-34], also please refer to the discussion under “response to arguments”).

Regarding claim 13, Hideyuki discloses an optical scanning device comprising:

a platen (2) defining a scanable surface, the platen comprising an essentially transparent surface defined by an upper side and a lower side, the scanable surface being defined by a first edge and a second edge orthogonal to the first edge (drawing 2(A));

a scanning light source (drawing 1, lamp 53) configured to optically scan an object placed proximate the upper side of the platen (51), the scanning light source being located proximate the lower side of the platen (drawing 1);

a scan window definition device (drawing 2 manuscript positioning 3) to allow a user to define a selected scan window (11) on the platen to be scanned by the scanning light source; and

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a scan window illumination device comprising a light source (LEDs 8-9) configured to generate a focused beam of light to trace at least part of a perimeter of the scan window (11) by directing the focused beam of light toward at least one of the upper side and the lower side of the scanable surface (paragraph [0031-34], also please refer to the discussion under “response to arguments”).

Regarding claim 15, Hideyuki discloses the optical scanning device of claim 13, and wherein the scan window definition device is used to direct the focused beam of light (drawing 2, LEDs 8-9).

Regarding claim 16, Hideyuki discloses the optical scanning device of claim 13, and further wherein the optical scanning device further comprises a back-lighting light source (53) positioned to direct light to the lower side of the platen (51, drawing 1).

Regarding claim 18, Hideyuki discloses the optical scanning device of claim 15, and wherein the scan window definition device (LEDs 8-9) comprises a user interface allowing a user to identify positions along the first and second edges of the scanable surface to thereby define the selected scan window (11, drawing 2(A)).

6. *Allowable Claims*

Claims 1, 2, 7 and 8 are allowed for the reason that the prior art does not teach in claimed combination, “... the plurality of moveable position markers includes a light source on the at least one of the plurality of markers and configured to direct light into at least one of the sides of the member.”

Claim 21 is allowed for the reason that the prior art does not teach in claimed combination, "... generating signals to define the portion of the perimeter for the tracing and using the signals to direct the focused beam of light."

7.

Allowable Subject Matter

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach "... a plurality of moveable position markers configured to move along the first and second edges of the scanable surface and thereby define the selected scan window, the apparatus further comprising a plurality of position detectors configured to detect the positions of the plurality of position markers along the first and second edges of the scanable surface and to generate position signals in response thereto..."

Claims 11 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach "... an oscillating mirror, wherein the focused beam of light is generated by a laser and is directed by the oscillating mirror to trace at least a part of the perimeter".

Claims 12 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach "... a rotating polygonal-sided mirror, wherein the focused beam of light is generated by a laser and is directed by the rotating polygonal-sided mirror to trace at least a part of the perimeter".

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Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art does not teach "... a plurality of position markers configured to move along the first and second edges of the scanable surface and thereby define scan window."

8.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9.

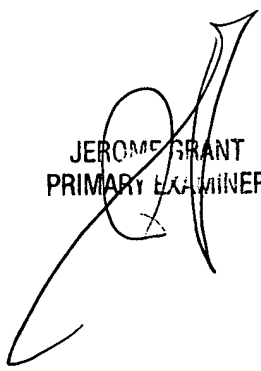
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Houshang Safaipoor
Patent Examiner
October 13, 2006


JEROME GRANT
PRIMARY EXAMINER